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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,059	05/20/2004	Mari Saito	253326US6	6760

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EXAMINER

VY, HUNG T

ART UNIT	PAPER NUMBER
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2163

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/849,059

Applicant(s)

SAITO ET AL.

Examiner

Hung T. Vy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

**DETAILED ACTION
Specification**

1. The specification has been checked to the extent necessary to determine the presence of possible minor errors. However, the applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, the phrase "an unnecessary word" renders the claim indefinite because it is not clear what is an unnecessary word. In specification fails to recite what is "an unnecessary word".

Claims 4-5 depend from rejected claim 3 thereby render these dependent claims indefinite

Claim Rejections - 35 USC 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-13 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, the claims are not directed towards the final

result that is "useful, tangible and concrete".

(See State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

According to the New Guidelines of October 26, 2005, which states that "A claim limited to a machine or manufacture, which has a practical application, is statutory. In most cases a claim to a specific machine or manufacture will have a practical application. See Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557)... a specific machine to produce a useful, concrete, and tangible result and State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

(Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility

<http://rs6.net/tn.jsp?t=mdmd7pbab.0.kbg76pbab.p9qiiibab.7440&p=http%3A%2F%2Fwww.uspto.gov%2Fweb%2Foffices%2Fpac%2Fdapp%2Fopla%2Fpreognotice%2Fguidelines101_20051026.pdf>)

Examiner requests Applicant to include in Applicant's claimed limitations (in all the claims) the following:

What is the practical application?

What is the result?

What is final result that is concrete, useful and tangible?

Because the "practical application, result, concrete, useful and tangible"

limitations are not claimed in Applicant's claims, Examiner believes that the above listed claims are nonstatutory.

With respect to claim 1 recites information processing apparatus, however the components of the system are merely software per se. A system claims much recite physical structure thus enabling it to be properly categorized in one of the statutory categories of invention. Since the components of the apparatus of claim 1 is software per se and do not

contain any physical components, the systems cannot be categorized in one of the statutory categories of invention and is thus nonstatutory.

Further, in the claim 11, an information processing method does not produce a useful, concrete and tangible result as set forth in 2106 (IV)(B)(2)(b)(ii), e.g. *by storing said metadata assigned with said attribute item into a database* is not a tangible result because *by storing said metadata assigned with said attribute item into a database* is not being used in *an information processing method* as recited in the preamble. The claim invention does not produce a useful because the process does not meet the requirement as recited in the preamble, e.g., *information processing*.

With respect to claim 12, a program for making a computer execute the controlling steps does not produce a useful, concrete and tangible result as set forth in 2106 (IV)(B)(2)(b)(ii), e.g. *by storing said metadata assigned with said attribute item into a database* is not a tangible result because *by storing said metadata assigned with said attribute item into a database* is not being used in *a program for making a computer execute the controlling steps* as recited in the preamble. The claim invention does not produce a useful because the process does not meet the requirement as recited in the preamble, e.g., *a program for making a computer execute the controlling steps*.

With respect to claim 13, *a recording medium recording a program for making a computer execute the controlling steps* does not produce a useful, concrete and tangible result as set forth in 2106 (IV)(B)(2)(b)(ii), e.g. *by storing said metadata assigned with said attribute item into a database* is not a tangible result because *by*

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storing said metadata assigned with said attribute item into a database is not being used in a recording medium recording a program for making a computer execute the controlling steps as recited in the preamble. The claim invention does not produce a useful because the process does not meet the requirement as recited in the preamble, e.g., a recording medium recording a program for making a computer execute the controlling steps.

Claims 2-10 depend from rejected claim 1 thereby render these dependent claims nonstatutory

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 6 and 11-13 are rejected under 35 U. S. C. § 102 (e) as being anticipated by Quinn et al. (U.S. Pub. No. 2003/0135513).

With respect to claims 1 and 11-13, Quinn et al. discloses an information processing apparatus comprising: metadata acquisition means for acquiring metadata of content (102,144 or 202) (see fig. 1-2 and paragraph 0054); metadata analysis means for analyzing an attribute of said metadata acquired by said metadata acquisition

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means (categorized, genre) (150-153 or 208)(see paragraph 0055); dictionary generation means for generating dictionary data for correlating said attribute with an attribute item contained (150-153) (see paragraph 0055) (Selection algorithms 155-158 are used to select a most likely correct artist name, track title, album title, year, etc. based on the size of the probability of the most **frequently occurring** data item, e.g., artist spelling, total number of **occurrences** of that data item or spelling and the size of the probability of alternatives to that data item, such as different artist spellings) in said attribute on the basis of an analysis result acquired by said metadata analysis means (150-153); and database generation means for assigning said attribute item (artist, title, album, year) to metadata acquired by said metadata acquisition (144) means on the basis of said dictionary data generated (150-153) (see fig. 2) by said dictionary data generation means and storing said metadata assigned with said attribute item into a database (120 or 218) (see fig. 2).

With respect to claim 2, Quinn et al. discloses dictionary generations means detects, from among words contained in said metadata, a word which is high in co-occurrence in metadata having a particular attribute item as a keyword of said attribute item (see paragraph 0055) (Selection algorithms 155-158 are used to select a most likely correct artist name, track title, album title, year, etc. based on the size of the probability of the most **frequently occurring** data item, e.g., artist spelling,

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total number of **occurrences** of that data item or spelling and the size of the probability of alternatives to that data item, such as different artist spellings), thereby correlating said attribute item of said metadata with said keyword (artist, title, album, year)(see fig. 2, 4).

With respect to claim 6, Quinn et al. discloses resolving means for resolving said metadata into components (artist, title, album, year) and storage (120) means for collecting said metadata resolved by said resolving means for each attribute item, and storing the collected metadata (see fig. 2).

6. Claims 1-2, 6 and 11-13 are rejected under 35 U. S. C. § 102 (a) as being anticipated by Applicant Admitted Prior Art in background of invention (AAPA).

With respect to claims 1 and 11-13, AAPA discloses an information processing apparatus comprising: metadata acquisition means for acquiring metadata (EPG) of content (see fifth paragraph); metadata analysis means for analyzing an attribute of said metadata acquired by said metadata acquisition means categories (drama, variety, etc.), his favorite genre names (drama, music, etc.)(See last paragraph of page 1 of specification); dictionary generation means for generating dictionary data for correlating said attribute with an attribute item contained (see second paragraph, page 2 in speciation)(the program metadata associated with the viewed program is accumulated, and when the viewing log (or program metadata) has been accumulated to a predetermined amount, this viewing log is analyzed to acquire program names to be recommended) in said attribute on the basis of an analysis result acquired by

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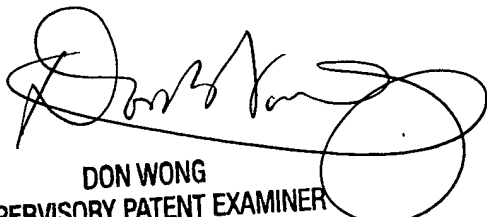
said metadata analysis means; and database generation means for assigning said attribute item (genre names, etc) to metadata acquired by said metadata acquisition means on the basis of said dictionary data generated (viewing log) by said dictionary data generation means and storing said metadata assigned with said attribute item into a database (see second-third paragraph, page 2 in specification).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung T. Vy whose telephone number is 571-2721954. The examiner can normally be reached on 8.30am - 5.30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571 272 1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DON WONG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

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October 29, 2006.